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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,977	12/11/2003	Mateen Jamil Greenway	50-03-022	8545

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EXAMINER

LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/732,977

Applicant(s)

GREENWAY, MATEEN JAMIL

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's request for pre-appeal review of the final rejection is persuasive and, therefore, the finality of that action is withdrawn. Applicant filed a reply dated October 24, 2006, in response to the advisory action mailed October 12, 2006. In the response, applicant has submitted no claim amendments. Applicant has provided arguments in support of the originally filed claims. Applicant's arguments are herein addressed.

Response to Arguments

Applicant's arguments, see request for review, filed October 24, 2006, with respect to the rejection(s) of claim(s) 1, 8, and 15, under 35 USC § 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under 35 USC § 103(a).

With regard to applicant's arguments that "services are provided within an enterprise common operating environment," is not taught in the prior art, applicant's arguments have been fully considered but they are not persuasive. Applicant's specification describes services being provided within an enterprise common operating environment as a common operating environment where the enterprise is a company, government, school, or other similar enterprise. A common operating environment could describe any system or network operating within an organization, an intranet or

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private network, or even any public network or operating system, provided it has more than one user. Therefore, even if the specification's description of "enterprise" is carried over to the claim, the more narrow interpretation of the claim still describes services provided in virtually any operating environment with more than one user. Applicant's arguments indicate an assumption that the origin of the service somehow restricts the services from being provided within the described environment. There is no basis in the claim for this assumption. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims, as applicant acknowledges in the specification at paragraphs 0055-0056. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The argument that the prior art teaches away simply due to the source of the services provided is inconsistent with the teaching of the prior art that clearly shows the services provided within an enterprise common operating environment regardless of the source. The prior art teaches use within both public and private networks, as well as hybrid networks (column 1 lines 34-36, column 2 lines 49-56, column 7 lines 11-16, column 19 line 58 – column 20 line 4). Far from teaching away, the prior art teaches use in a range of operating environments, much the same as the present application. An inventive aspect of the prior art is its teaching of providing services over a public (untrusted) network that rise to the same trusted level as those provided within a private network, or virtual network.

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because:

- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "224" has been used to designate both "Expansions Bus Interface" and "Audio Adapter." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the description: 102,155,212,214,216, and 218. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the description: 102,222,226, and 228. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

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action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper (Paper # 051222; US Pat. No. 5,815,665) in view of Shavit (US Pat. No. 4,799,156).**

Teper teaches methods and systems for providing a selection of services to users over a distributed network with both client and server based applications (see at least abstract, Fig.1). Teper teaches a) providing a selection or various services to users, b) delivering services to users within a common operating environment, c) billing users for chosen services, and d) availability within a range of operating systems, public and private networks. Teper further teaches:

- sending a list of available services to be displayed to a user: (see at least Fig.1, column 4 lines 15-27, column 8 lines 59-62, column 12 lines 24-29); wherein the services include local applications or server-based applications (see at least abstract, Figs.1,3,4, column 7 lines 44-47 column 11 lines 34-53, column 13 lines 17-29, column 14 lines 53-61); wherein the list of available services is customized to the user's role within the enterprise (see at least column 4 lines 22-24, column 5 lines 49-55, column 12 lines 24-29)
- receiving a user selection of a service: wherein the user can thereby select only required services to use within a common operating environment (see at least column 4 lines 15-25, column 12 lines 24-29, column 15 lines 35-45).
- providing the selected service to the user: in an enterprise common operating environment (see at least abstract, column 1 lines 13-23, 34-36; column 6 lines 53-61, column 11 lines 32-33).
- creating a billing record: indicating the selected service and the user wherein each service can be individually selected and billed to the user, and wherein the services are billed to the user's business unit (see at least column 3 lines 32-45,

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column 4 lines 25-27, 36-40, column 5 lines 38-44, column 6 lines 46-49, column 7 lines 35-37. Please note: There is no functional distinction between billing the user and billing the user's business unit, it therefore will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); In any case, the prior art is not limited to one or the other definition, see at least column 7 lines 1-16.)

- storing the user selection: (see at least column 1 lines 17-22, column 3 lines 34-36, column 3 line 65 – column 4 line 14, column 6 lines 27-33, 53-61, column 8 lines 12-19).
- a processor and accessible memory: (see at least claim 45, column 26 lines 40-46)

Teper teaches all of the above and teaches a) services including software programs, b) service providers and users included on a common network, c) charging users for using services on a per-service or per-unit-time basis, d) billing users for all chosen services in a single bill, and e) sending a list of available services to be displayed to a user. Teper does not however disclose the list including pricing information for at least some available services. Shavit teaches an interactive marketing system and teaches a) service providers and users on a common network, b) charging users for services on a per-service basis, c) selective access to electronic resources, and d) sending a list of available services to be displayed to a user. Shavit also teaches the list including pricing information for at least some available services

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(see at least column 12 line 54-65, and column 15 lines 45-60). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Teper to include pricing information for at least some available services in a list of available services displayed to a user, in order to further the function of generating commerce by allowing users to access more service information and make informed choices, thereby increasing commerce using the method and system.

Pertaining to machine readable computer program product Claims 15-21

Rejection of Claims 15-21 is based on the same rationale as noted above.

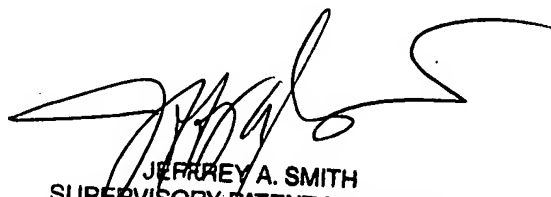
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
February 14, 2007


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